

Remarks

On behalf of the Applicant, the undersigned wishes to express appreciation to Examiner Ackun for the courtesies extended during the personal interview conducted on June 21, 2004. During the interview, the subject matter of Claim 1 in view of the references cited below was discussed with the Examiner. On behalf of the Applicant, the undersigned discussed both the distinguishing features of the present invention and potential new claim language with the Examiner. The Examiner noted that the final decision regarding the outstanding rejections would be made pursuant to the submission of this response. Favorable reconsideration of this application is respectfully requested in light of the following remarks.

Specification Amendments

Applicants have amended the specification to correct typographical errors. No new matter has been added.

Rejection of Claims 1-12 Under 35 U.S.C. § 112

Claims 1-12 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 1 has been amended to clarify the invention. Accordingly, claim 1 as amended, and the claims which depend therefrom, are allowable.

Rejection of Claims 1-23 Under 35 U.S.C. § 102

Claims 1-23 stand rejected under 35 U.S.C. § 102(b) and / or 35 U.S.C. § 102(e) as being anticipated by the following U.S. Patents: 5,301,478 to *Maese, Jr.*; 6,572,436 to *So*; 6,672,659 to *Melohn et al.*; 6,066,022 to *Fobean et al.*; 4,070,789 to *Levenson*; 3,341,987 to *Johansson*; and 5,096,204 to *Lippman*.

The invention as recited in independent claim 1 includes: 1) a base member configured to be substantially parallel to a support surface; 2) a support member pivotally coupled to the base member; and 3) an extension member. Independent claim 1 recites that the support member is “movable between a first configuration in which a side of said support member is substantially perpendicular to said base member and a second configuration in which said side of said support member is substantially parallel to said base member.” Independent claim 1 further recites that the extension member is “movable between a first configuration in which said extension member is retracted when said support member is in the first configuration associated with said support member and a second configuration in which said extension member is coupled to said support member and angularly disposed with respect to said support member when said support member is in the second configuration associated with said support member, said extension member being configured to substantially support the weight of a user . . .”

To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, every element as set forth in the claim must be found either expressly or inherently in a single prior art reference. See MPEP § 2131. The fact that a certain characteristic may occur in the prior art is not sufficient to establish inherency. Rather, to establish inherency, the undisclosed characteristic

must be shown to be necessarily present and so recognized by persons of ordinary skill in the art.

See MPEP § 2112. The burden is on the examiner to “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *See MPEP § 2112* (emphasis in original). In this instance, the Examiner has failed to establish a *prima facie* case of anticipation for at least the reason that the cited references do not expressly or inherently contain every element as set forth in the claims.

Maese, Jr. discloses a child playhouse structure that is designed to be easily constructed and foldably stored during periods of non-use. As shown in Figures 1 and 2, the playhouse disclosed in *Maese, Jr.* includes a series of panels that are hingedly mounted together. At a minimum *Maese, Jr.* does not disclose or suggest that the extension member be “retracted when said support member is in the first configuration . . .” or that the extension member “be configured to substantially support the weight of a user . . .” Additionally, *Maese, Jr.* fails to disclose or suggest a slide member being “configured to substantially support the weight of a user . . .” as recited in independent claims 13 and 22.

So discloses a modular toy station that can be transformed from a closed storage configuration to an open configuration suitable for play. Figures 1 through 3 of *So* disclose a platform 14 and two box halves 12, 13 that are hingedly mounted thereto, while Figure 9 shows a ramp piece 22. The invention as recited in claim 1 is not anticipated by *So* for at least the reason that *So* does not disclose or suggest that the extension member be “coupled to said support member . . .” Instead, *So* discloses that the ramp piece 22 is coupled directly to the edge of the platform 14 (Col. 2, lines 51-52). Furthermore, *So* discloses miniature toys (Col. 2, lines 49-51),

and hence does not disclose or suggest that the extension member be “configured to substantially support the weight of a user . . .” Additionally, *So* fails to disclose or suggest a slide member being “configured to substantially support the weight of a user . . .” as recited in independent claims 13 and 22.

Melohn et al. discloses a toy lounge chair that is convertible into a vanity. Figures 3 through 6 of *Melohn et al.* disclose a base section 18 that is connected to a series of sections that are moveable with respect to the base section 18. At a minimum, *Melohn et al.* discloses a small scale toy, and hence does not disclose or suggest that the extension member be “configured to substantially support the weight of a user . . .” For example, *Melohn et al.* states that the toy should be constructed “to be usable with a child playing with dolls . . .” (Col. 3, lines 12-13). Furthermore, the toy disclosed in *Melohn et al.* consists of sections that are on the order of two inches in width (Col. 3, line 20). Additionally, *Melohn et al.* fails to disclose or suggest a slide member being “configured to substantially support the weight of a user . . .” as recited in independent claims 13 and 22.

Fobean et al. discloses a child’s activity center that is collapsible from an open play position to a closed storage position. Figure 1 of *Fobean et al.* shows two walls 14, 16 attached to a frame 12. The invention as recited in claim 1 is not anticipated by *Fobean et al.* for at least the reason that *Fobean et al.* does not disclose or suggest that the extension member be “coupled to said support member . . .” Instead, *Fobean et al.* discloses that each of the walls 14, 16 are coupled directly to the frame 12. Additionally, *Fobean et al.* fails to disclose or suggest a slide member being “configured to substantially support the weight of a user . . .” as recited in independent claims 13 and 22.

Levenson discloses a multi-level doll house that may be folded into a single level carry case. Figures 2 and 3 of *Levenson* disclose a series of moveable walls that are attached to the bottom portion 26 of the upper structure. The invention as recited in claim 1 is not anticipated by *Levenson* for at least the reason that *Levenson* does not disclose or suggest that the extension member be “retracted when said support member is in the first configuration associated with said support member . . .” Furthermore, because *Levenson* discloses folding doll houses it does not disclose or suggest that the extension member be “configured to substantially support the weight of a user . . .” Additionally, *Levenson* fails to disclose or suggest a slide member being “configured to substantially support the weight of a user . . .” as recited in independent claims 13 and 22.

Johansson discloses a collapsible house that may be folded into a compact structure. Figures 1 through 4 of *Johansson* disclose a series of foldable wall sections that are hingedly attached to a floor section 2. The invention recited in claim 1 is not anticipated by *Johansson* for at least the reason that *Johansson* does not disclose or suggest that the extension member be “configured to substantially support the weight of a user . . .” Additionally, *Johansson* fails to disclose or suggest a slide member being “configured to substantially support the weight of a user . . .” as recited in independent claims 13 and 22.

Lippman discloses a book containing leaves of various shapes or sizes so that the assembled book provides a three-dimensional sculpture. As shown in Figure 2, the book disclosed in *Lippman* includes a series of interconnected leaves that can be folded together in a variety of positions. At a minimum, because *Lippman* discloses books that are described as being compact (Col. 5, line 67) and containing leaves held together by paper (Col. 6, line 4),

Lippman does not disclose or suggest that the extension member be “configured to substantially support the weight of a user . . .” Additionally, *Lippman* fails to disclose or suggest a slide member being “configured to substantially support the weight of a user . . .” as recited in independent claims 13 and 22.

For at least the above reasons, independent claims 1, 13, and 22 are allowable over the cited references. Based at least on their dependency upon independent Claims 1, 13, and 22, dependent Claims 2–12, 14–21, and 23 are also allowable.

Rejection of Claims 1-23 Under 35 U.S.C. § 103

Claims 1-23 stand rejected under 35 U.S.C. § 103 as being obvious in view of the references discussed above. The Official Action further states that “[i]n the event the references are later deemed not to show either visual or audible outputs as claimed it would have been obvious to provide the same with all of the devices disclosed . . .” The Applicant respectfully disagrees with this position.

To establish a *prima facie* case of obviousness, the evidence must show all of the following: 1) a sufficient motivation or teaching to combine or modify the references; 2) a reasonable expectation of success resulting from the combination or modification; and 3) that the references as combined teach all of the claim limitations. *See MPEP § 2143.* In this instance, the Examiner has failed to establish a *prima facie* case of obviousness for at least the reason that the applied references do not disclose all of the claim limitations of the present invention.

Claims 1–23 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Melohn et al.* Under 35 U.S.C. § 103(c), however,

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

At the time the claimed invention of the present application was made, *Melohn et al.* and the present application were owned by and/or subject to an obligation of assignment to the same “person,” Mattel, Inc. Thus, *Melohn et al.* cannot be properly considered prior art under 35 U.S.C. 103. Accordingly, the Applicant respectfully requests that the rejection under 35 U.S.C. 103 be withdrawn.

The Applicant acknowledges that the remaining qualifying references disclose a variety of devices that are collapsible to facilitate storage or portability. The foldable components of the cited references, however, are not “configured to substantially support the weight of a user . . .” Rather, the components disclosed in the cited references were generally selected to be compatible with miniature toys or children’s play houses. Components selected to be suitable for doll houses, play houses, and the like are not necessarily configured to substantially support the weight of a user” as recited in independent claims 1, 13, and 22. Additionally, because the cited references pertain to miniature toys or play houses, they do not suggest any motivation to modify the components disclosed to be “configured to substantially support the weight of a user . . .”

Finally, while the Applicant acknowledges that *Fobean et al.* discloses an activity center that includes attachments to stimulate a child, for at least the reasons stated above, the references alone or in combination do not disclose all of the claim limitations of the invention.

For at least the above reasons, independent claims 1, 13, and 22 are allowable over the cited references. Based at least on their dependency upon independent Claims 1, 13, and 22, dependent Claims 2–12, 14–21, and 23 are also allowable.

Conclusion

All of the stated grounds for rejection have been properly traversed or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes that further personal communication would be helpful in the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

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